

## REMARKS

Claims 5-7, 10-13, and 16-26 are pending in the application. Claim 10 has been withdrawn as being directed to a non-elected species (original Species B). Claims 16-22 have been withdrawn as being directed to a non-elected invention (Group III). In the Office Action mailed April 27, 2010, the Applicants are required to elect one of five patentably distinct species for the step of modifying the patterned film:

Species (A): removing material from the patterned film using a sharp tip;

Species (B): adding material to the patterned film using a sharp tip;

Species (C): removing material from the patterned film by addition of a solvent;

Species (D): removing material from the patterned film using electromagnetic radiation; and

Species (E): curing material in the patterned film to prevent its transfer.

Claim 5 is considered to be generic.

### I. Election with Traverse

The Applicants respectfully traverse the requirement for restriction. This traversal is expressly not made on the grounds that the species as defined by the Office Action are not patentably distinct. Rather, the Applicants traverse on the grounds of (1) failure of the requirement to demonstrate that the restricted limitations are mutually exclusive, as is required for the designation of separate species, and (2) failure of the requirement to make a prima facie case that there will be an examination and search burden for the restricted species.

The restriction requirement fails to set forth a prima facie case that the restricted limitations are separate species because they are mutually exclusive, presenting only conclusory statements to that effect. In fact, the language of claim 5 makes it clear that the restricted limitations are not mutually exclusive, in that they are claimed as being practicable together, with claim 5 specifically reciting "modifying the patterned film by one or more of the steps of ...". It is further clear to one of skill in the art that practicing any one of the recited steps does not exclude practicing any, or even all, of the others within a single application of the method of the Applicants' invention. It is further to be noted that the requirement fails to indicate that there are separate classes and/or sub-classes for each restricted limitation, and hence the requirement fails

in this way also to demonstrate that the restricted limitations are mutually exclusive. The Applicants therefore respectfully submit that the restriction requirement fails to meet the burden of demonstrating that the restricted limitations are separate species by virtue of being mutually exclusive. Withdrawal of the restriction requirement and examination of all claims is therefore respectfully requested.

The restriction requirement further fails to set forth a prima facie case that there will be an examination and search burden for the restricted species, again presenting only conclusory statements to that effect. As noted above, the requirement fails to indicate the class/sub-class for each restricted species, and hence the requirement also fails to demonstrate that the restricted species require a different field of search. Furthermore, the Applicants note that there have been three previous Office Actions in this application, and that the step “modifying the patterned film” has been present in the claims from the beginning of prosecution, being originally recited in original dependent claim 14 (now cancelled) and later incorporated into underlying independent claim 5. Hence, this step, which was necessarily interpreted as encompassing all possible substeps including those substeps now specifically recited in amended claim 5, has already been amply searched, and thus there is no examination and search burden due to the limitation of this element to requiring at least one of only five of the possible substeps encompassed within the scope of the recited element. The Applicants therefore respectfully submit that the restriction requirement fails to meet the burden of demonstrating an examination and search burden for the restricted species. Withdrawal of the restriction requirement and examination of all claims is therefore respectfully requested.

Despite the traversal of this requirement outlined in the foregoing, the Applicants herein elect, with traverse as outlined above and as required under 35 U.S.C. 121, to prosecute Species (E) (“curing material in the patterned film to prevent its transfer”; claims 5-7, 11-13, and 23-26) on the merits if the species restriction requirement is maintained. This election is being made with the express understanding and expectation that the search will be continued to cover all claims, covering all embodiments of all species, if the initial search and examination finds that the generic claims under examination are patentable. If the requirement for restriction is maintained, the Applicants expressly reserve the rights to rejoinder of all species and embodiments upon the allowance of a generic claim and to prosecute any nonelected species in one or more subsequent divisional or continuation applications.

## **II. Conclusion**

Claims 5-7, 11-13, and 23-26 have been elected for prosecution on the merits, with the further election of Species (E), with traverse, and the expectation that all non-elected species will be examined if the generic claim is allowed. The Applicants respectfully submit that claims 5-7, 10-13, and 23-26 are now in condition for allowance, which action is therefore requested. The Applicants further believe that this application is now in condition for allowance, which action is now earnestly and respectfully solicited. Should there remain any unresolved issues, it is respectfully requested that the Examiner telephone Norma E. Henderson, Applicant's Attorney, at 603-437-4400, so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,



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